

Hearing:
November 18, 1998

Paper No. 44
HRW

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB

AUG 4, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

United Technologies Corporation

v.

P&W International Tech Co., Inc.

Opposition No. 101,322
to application Serial No. 74/573,108
filed on September 13, 1994

Ronald G. Cummings for United Technologies Corporation.

Jack Peng for P&W International Tech Co., Inc.

Before Simms, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

P&W International Tech Co., Inc. has filed an
application to register the mark P&W and design, as shown
below, for "synthetic diamond for abrasive use" in Class 3
and "hand-powered steel drills and chucks therefor" in Class

8.¹

United Technologies Corporation has filed an opposition to registration of the mark, on the grounds of priority and likelihood of confusion under Section 2(d) and of misuse by applicant of the statutory notice of registration.

Opposer, in its notice of opposition, alleges prior use of the designation P&W in connection of the sale of a variety of tools, including drills, drill chucks and tools for abrasive use; ownership of registrations for the marks PRATT & WHITNEY, P&W, and PW for engines for powering aircraft and replacement parts therefor; prior use by both opposer and its customers of the designation P&W as an indication of source of opposer's products; and the likelihood of confusion of applicant's mark with opposer's trade name, trademarks and previously used designation. In its amended notice, opposer added the allegation that applicant had misused the registration symbol with the intent to deceive the public.

¹ Serial No. 74/573,108, filed September 13, 1994, claiming first use dates for the Class 3 goods of October 18, 1993 and first use dates for the Class 8 goods of February 2, 1994. The mark is described in the application as consisting "in part of the design of a sailboat and waves, with the sailboat representing the letter P and the waves representing the letter W."

Opposition No. 101,322

Applicant, in its answer, admitted opposer's ownership of its pleaded registrations and that opposer is well known for the manufacture and sale of engines for powering aircraft, but denied the remainder of the salient allegations. In its answer to the amended notice, applicant denied the allegations of misuse.

The Record

The record consists of the file of the involved application; the trial testimony taken by opposer of James F. Guiliano, General Manager of Tool Support Services for Pratt & Whitney (a division of opposer), H. Christian Conover, Manager Advertising and Communications for Pratt & Whitney, and Mary Krywonis, legal assistant for Pratt & Whitney; the exhibits accompanying each of these depositions; opposer's first notice of reliance introducing status and title copies of its three pleaded registrations and its second notice of reliance introducing numerous publications in which reference is made to Pratt & Whitney as P&W. Applicant took no testimony and made no other evidence of record. Opposer filed a brief and both parties participated in an oral hearing.

Mr. Conover, in his deposition, introduced several advertising brochures for the Pratt & Whitney engine product line showing use of the PRATT & WHITNEY mark and reference

to the company as P&W. No mention was made in these brochures of any tools being marketed by opposer.

Ms. Krywonis testified that Pratt & Whitney had been using this company name since 1926; that it has been referred to both internally and by the public as P&W since that time; and that the company started using PRATT & WHITNEY alone, as opposed to PRATT & WHITNEY AIRCRAFT, as its trademark in 1983. Ms. Krywonis introduced the results of a Lexis/Nexis search showing over 3,000 hits for the period since 1986 in which the company was referred to, in the same article, as both Pratt & Whitney and P&W; printouts of screens from the company's Internet site in which both designations were used; and copies of various company agreement forms in which the company refers to itself as P&W. In addition, Ms. Krywonis made of record an envelope in which a paper was received from applicant during the course of this proceeding, the mailing label of which shows use by applicant of the ® symbol next to its mark (Exhibit 21).

Mr. Guiliano, testifying as the person responsible for all tool sales at Pratt & Whitney, stated that the company has been selling tools since it went into business in approximately 1925;² that opposer offers over 14,000 stock

² While opposer designated its sales figures for the tool business, as testified to by Mr. Guiliano, "confidential," opposer, in its brief, has stated that these sales in 1996

Opposition No. 101,322

tools including drill bits³ and chucks similar to those sold by applicant; and that opposer has sold tools with a synthetic diamond coating on the surface, such as polishing and grinding balls and wheels, for at least 20 years. Mr. Guiliano identified a shipping label bearing the trademarks P&W and PW (Exhibit 10) and a container to which one of these labels had been applied (Exhibit 11) as being exemplary of the type used to ship tools to customers since 1984. He testified that these customers are typically commercial customers, such as airlines, overhaul shops and maintenance providers, and that in correspondence these customers frequently refer to the company as P&W or P&W Tool Support Services, as exemplified by Exhibits 12 A-J. He further testified that the tools sold by the company are manufactured by 50 to 60 different outside manufacturers and that the part numbers imprinted on the tools are typically in the format of PWA (Pratt & Whitney Aircraft) numbers.

The Opposition

Opposer is relying upon three separate bases in connection with its claim under Section 2(d), namely,

exceeded \$9 million. Although this number is small in comparison to the gross revenues of Pratt & Whitney which, according to opposer's brief, range near \$6 billion, opposer's tool business is clearly not insubstantial.

³ Although applicant identifies its products as "drills" rather than "drill bits," it appears that the goods shown in the specimens are more aptly described as "drill bits."

Opposition No. 101,322

(1) its common law use of the trademark P&W on tools, (2) its trademark registrations for the marks P&W and PW for engines for powering aircraft and replacement parts therefor, and (3) its trade name use and use analogous to trademark use of the designation P&W.

We can summarily discount any reliance by opposer on its pleaded registrations. Regardless of the similarity of the registered marks and applicant's mark, we consider airplane engines and drills or synthetic diamond abrasive material much too dissimilar to seriously contemplate any likelihood of confusion. Although opposer argues that engine manufacturers would be expected to sell tools, opposer has offered no evidence of companies other than opposer which follow this practice. Moreover, while applicant has admitted that opposer is well-known for its manufacture of aircraft engines, opposer has provided no basis for so extending this fame to encompass the totally different field of tools and abrasive materials for use in making and/or repairing abrasive tools.

Turning to opposer's common law use of the mark P&W, we find that, by the testimony of Mr. Guiliano, opposer has established that opposer, through the Pratt & Whitney division, has been selling tools since approximately 1925 and that labels with the marks P&W (and PW) have been used on containers used for shipping these tools since 1984. In

Opposition No. 101,322

looking at the shipping labels used by opposer, we note that, although the Pratt & Whitney trademarks are the predominant marks, the P&W and PW marks are also present, albeit in much smaller print on the side of the label. Despite the size of these marks, we believe that they would be viewed by purchasers as a separate indication of the source of the goods. See Franklin Mint Corp. v. Master Manufacturing Co., 677 F.2d 1005, 212 USPQ 233 (CCPA 1981), citing In re Singer Manufacturing Co., 255 F.2d 939, 118 USPQ 310 (CCPA 1958) for the statement that "[t]he important question is not how readily the mark will be noticed, but whether, when it is noticed, it will be understood as indicating origin of the goods." Accordingly, opposer has clearly shown priority of use of its P&W trademark in connection with the sale of its tools. The fact that the tools are ordered by PWA number, not P&W number, or that the P&W mark is not found on the tools per se, but rather is found on the packaging for the tools, is inconsequential.

As a result, we need not consider the evidence introduced by opposer with respect to the use by both the company and by others of the acronym P&W in reference to Pratt & Whitney, or whether this claimed recognition of P&W as a trade name would extend to its subsidiary tool business.

Opposition No. 101,322

We go forward to the issue of likelihood of confusion and to a review of those of the du Pont factors which are relevant under the present circumstances. See *In re Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Considering first the respective marks, we find opposer's mark P&W very similar in appearance, sound, and connotation to applicant's P&W and design mark. Although it is true that in determining likelihood of confusion, the marks must be considered in their entireties, there is nothing improper in giving more or less weight to a particular feature of a mark. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). If the word portion of a mark rather than the design feature is more likely to be remembered and relied upon by purchasers in referring to the good, it is the word portion which will be accorded more weight. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Here we believe the word portion, or to be more exact, the letters P&W, would be the dominant portion of applicant's mark. The design, if anything, serves to reinforce the letters rather than to create a separate commercial impression, since applicant has itself described the design as a depiction of the letters P and W in the form of a sailboat and waves. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d

1192 (TTAB 1994)[coat of arms design simply reinforces meaning of word mark].

Insofar as the goods are concerned, Mr. Guiliano testified that opposer sells drills (or drill bits) and chucks very similar to those shown in the specimens of applicant. While acknowledging that opposer does not sell the synthetic diamond material of applicant per se, Mr. Guiliano testified that opposer does sell abrasive tools which are coated with this material. He also testified to the possibility that opposer might sell the material itself in the future, to revitalize or repair its abrasive tools.

From opposer's evidence, and since applicant has offered nothing to the contrary, we find the tools sold by opposer to be highly similar, if not identical, to the hand-powered steel drills and chucks identified in applicant's application. There is no evidence warranting making any distinction on the basis that applicant's tools are "hand-powered."

Although there are obvious differences between the loose synthetic diamond abrasive material of applicant and the abrasive tools of opposer which incorporate this material, we find that there is a sufficient relationship between the abrasive material and tools which incorporate the material that purchasers might assume they originate from a common source. It is not necessary that the goods be

Opposition No. 101,322

identical, or even competitive, in order to support a finding of likelihood of confusion; it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons who, because of the similarity of the marks used thereon, might assume that they originate from, or are in some way associated with, the same producer. See *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985); and *Mobay Chemical Co. v. Standard Oil Co.*, 163 USPQ 230 (TTAB 1969). Since abrasive material similar to applicant's is used in opposer's polishing tools, and since we know from the testimony of Mr. Guiliano that abrasive material could be used to revitalize worn tools, we are led to the conclusion that there might well be common purchasers for the tools and the loose abrasive material. The assumption of a common source for the goods by these purchasers, if highly similarly marks are used thereon, is highly likely.

The only other relevant factor is the similarity or dissimilarity of the channels of trade for the respective goods. From the testimony of Mr. Guiliano, it is clear that opposer's tool customers are restricted almost exclusively to the aerospace industry. Applicant's goods, on the other hand, as identified in the application are unrestricted as to channels of trade or potential customers. Thus, we must

presume that the goods travel in all the normal channels of trade for these goods. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Since opposer has introduced testimony that it sells drills and chucks very similar to those of applicant, we assume that applicant's drills and chucks could also be sold to persons in the aerospace industry. No distinctions can be drawn on the basis of channels of trade.⁴

Accordingly, on the record before us, we find that, as a result of the high degree of similarity of applicant's P&W and design mark and opposer's previously used P&W mark, and of the fact that the goods upon which the respective marks are used are very similar or closely related, there is likelihood of confusion on the part of the purchasing public as to the source of the respective goods.

In view of this determination of likelihood of confusion, we find no need to entertain opposer's second ground for opposition, namely, the misuse by applicant of the registration symbol. Suffice it to say, the single instance of use by applicant of the symbol on an address label used in correspondence with opposer is far from

⁴ There is no evidence that opposer's tools are ever sold to the general public, whereas applicant stated at the oral hearing that its tools are only sold for home use. Not only is this fact not properly before us by way of timely introduced evidence, but we must consider the goods as identified and they are not so limited.

Opposition No. 101,322

conclusive evidence of fraudulent misuse by applicant of the symbol with an intent to deceive the purchasing public.

Opposition No. 101,322

Decision: The opposition is sustained and registration is refused to applicant.

R. L. Simms

C. E. Walters

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board